

Attorney Docket No. 200311972-1; Ser. No. 10/801,341

REMARKS

Reconsideration of the application as amended is respectfully requested.

The Examiner's communication dated January 9, 2006, which was a final office action and included new grounds of rejection, is acknowledged. This is the first opportunity applicants have had to respond to those new grounds of rejection. Therefore, the present amendment is necessary. Withdrawal of the finality of the rejection of January 9, 2006 is respectfully requested.

Claims 1 – 51 are pending. Of these, claims 32 – 51 are withdrawn from consideration under the restriction requirement. Claims 1 – 5, 7 – 14, 16 – 19, 23 – 26, 28 – 31, and 52 – 54 stand rejected as anticipated under 35 USC § 102. Claims 6, 15, and 27 stand rejected for obviousness under 35 USC § 103.

By the present amendment, claims 1, 2, 6, 11, 15, 21 – 23, 27, and 52 are canceled; non-elected claims 32 – 51 are also canceled in accordance with 37 CFR §1.144; claims 3 – 5, 7, 10, 12 – 14, 16, 18 – 20, 24 – 26, 28, 31, and 53 – 54 are amended; and new claims 55 – 57 are added. After this amendment, claims 3 – 5, 7 – 10, 12 – 14, 16 – 20, 24 – 26, 28 – 31, and 53 – 57 are pending.

Amendment of the specification (title)

The earlier amendment of the title to "THIN-FILM DEVICES AND METHODS FOR FORMING THIN FILMS THEREFOR" was entered, but the PAIR system now shows the title mis-spelled as "Thin-film devices and methods for *formity* thin films therefor" (italics added to indicate the error). Correction of the spelling from "formity" to "forming" is respectfully requested.

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Rejections under 35 USC § 102

Claims 1 – 5, 7 – 14, 16 – 19, 23 – 26, 28 – 31, and 52 – 54 stand rejected under 35 USC § 102 on new grounds as anticipated by the application of Peng et al., US 2002/0016075.

Claims 1, 2, 11, 23, and 52 are canceled hereinabove. Claims 3 – 5, 7, 10, 12 – 14, 16, 18 – 20, 24 – 26, 28, 31, and 53 – 54 are amended to more clearly state and distinctly claim what the applicants believe to be their invention and to make these claims dependent upon new claims 55 – 57. Claims 8, 9, 17, 29, and 30 are also made dependent upon new claims 55 – 57. No new matter is added.

The Examiner correctly points out that Peng et al. fails to teach the material layer comprising a sol-gel material. Thus, the claims as presently amended (all of which incorporate the limitation to the layer of sol-gel material), are all clearly distinguished from Peng et al.

Therefore, applicants respectfully request withdrawal of all of the rejections under 35 USC § 102 and allowance of claims 3 – 5, 7, 10, 12 – 14, 16, 18 – 20, 24 – 26, 28, 31, and 53 – 54, along with new claims 55 – 57.

Rejections under 35 USC § 103

Claims 6, 15, and 27 stand rejected for obviousness under 35 USC § 103 on new grounds as being unpatentable a combination of Harima et al., US 5,169,672 with Peng et al., US 2002/0016075. Applicants respectfully disagree with these rejections of claims 6, 15, and 27 on grounds that no *prima facie* case of obviousness has been established. It is well established law that the prior art must suggest the combination. Neither Harima et al., nor Peng et al., nor any of the prior art of record suggests the combination described by the Examiner in this rejection. Nevertheless, in the interest of compact prosecution, claims 6, 15, and 27 are canceled hereinabove without prejudice and replaced by new claims 55 – 57 and claims 52 – 53 as amended.

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New claims

New claims 55 – 57 are submitted to more clearly state and distinctly claim what the applicants would like to patent now, incorporating the subject matter of claims 6, 15, 27, and 52, and including the material layer comprising a sol-gel material that was not taught by Peng et al. Basis for these new claims is found in the specification as filed at page 3 line 10 through page 5 line 15 (paragraphs [0007] – [0010] of the published application US 2005/0202681), at page 6 lines 15 – 23 (paragraph [0013] of the published application), at page 13 line 20 – page 14 line 7 (paragraph [0027] of the published application), and in claims 1, 6, 11, 15, 22, 23, 27, 33, 36, 46, and 49 as filed. No new matter is added.

Conclusion

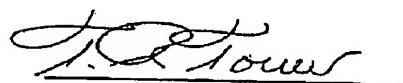
This response is believed to be fully responsive to each issue raised in the office action, but if the Examiner maintains any rejection, applicants would appreciate a more detailed explanation of precisely where in the references a combination is suggested and the relevant limitations are disclosed.

Applicants expressly reserve the right to file divisional and/or continuation applications with any of the canceled claims, or with similar claims, or with claims to any subject matter disclosed in the present application or incorporated by reference.

Applicants believe that the claims as amended are patentable over the prior art. The application is therefore believed to be in condition for allowance, which is respectfully requested.

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Respectfully submitted,
Curt Nelson et al.



By Theodore R. Touw
Reg. No. 36,702
Attorney/Agent for Applicants
Telephone: (541) 967-9133
Facsimile: (541) 967-9134

Hewlett-Packard Company
Attn: Kimberley Rockwood-Fuszek
1000 NE Circle Blvd.
Corvallis, Oregon 97330-4239
FAX: (541) 715-8581